



**U.S. Department of
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Trademark Office**
Assistant Commissioner for Patents

Fax Cover Sheet

Date: 6-9-99

To: Robert Bushnell	From: D. Boucher
Application Control Number: 08/1720070	Art Unit: 3627
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Re: 08/1720070	CC:

Urgent For Review For Comment For Reply Per Your Request

Comments:

Pls. find final dated Feb. 8, 1999.
Period for response runs from 2/8/99.

Number of pages 6 including this page

STATEMENT OF CONFIDENTIALITY

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Assistant Commissioner for Patents
Washington, DC 20231

patent by,

- (1) Identifying the patent,
- (2) Presenting a proposed count,
- (3) Identifying at least one claim in the patent corresponding to the proposed count,
- (4) Presenting at least one claim corresponding to the proposed count or identifying at least one claim already pending in its application that corresponds to the proposed count, and, if any claim of the patent or application identified as corresponding to the proposed count does not correspond exactly to the proposed count, explaining why each such claim corresponds to the proposed count, and
- (5) Applying the terms of any application claim,

- (i) Identified as corresponding to the count, and
- (ii) Not previously in the application to the disclosure of the application.

(6) Explaining how the requirements of 35 U.S.C. 135(b) are met, if the claim presented or identified under paragraph (a)(4) of this section was not present in the application until more than one year after the issue date of the patent.

(b) When an applicant seeks an interference with a patent, examination of the application, including any appeal to the Board, shall be conducted with special dispatch within the Patent and Trademark Office. The examiner shall determine whether there is interfering subject matter claimed in the application and the patent which is patentable to the applicant subject to a judgment in an interference. If the examiner determines that there is any interfering subject matter, an interference will be declared. If the examiner determines that there is no interfering subject matter, the examiner shall state the reasons why an interference is not being declared and otherwise act on the application.

(c) When an applicant presents a claim which corresponds exactly or substantially to a claim of a patent, the applicant shall identify the patent and the number of the patent claim, unless the claim is presented in response to a suggestion by the examiner. The examiner shall notify the Commissioner of any instance where an applicant fails to identify the patent.

(d) A notice that an applicant is seeking to provoke an interference with a patent will be placed in the file of the patent and a copy of the notice will be sent to the patentee. The identity of the applicant

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will not be disclosed unless an interference is declared. If a final decision is made not to declare an interference, a notice to that effect will be placed in the patent file and will be sent to the patentee.

If the applicant does not apply the terms of the claim presented to the disclosure of the application, i.e., does not state how each term of the copied claim is supported by the specification, as required by 37 CFR 1.607(a)(5), a one-month time period should be set for correction of this deficiency. Form Paragraph 23.12 should be used for this purpose.

COMPLIANCE WITH 35 U.S.C. 135(b)

If the claim presented or identified as corresponding to the proposed count was added to the application by an amendment filed more than one year after issuance of the patent, or the application was not filed until more than one year after issuance of the patent (but the patent is not a statutory bar), then under the provisions of 35 U.S.C. 135(b), an interference will not be declared unless at least one of the claims which were in the application, or a parent application, prior to expiration of the one-year period was for "substantially the same subject matter" as at least one of the claims of the patent.

Therefore, 37 CFR 1.607(a)(6) requires that the request for interference with the patent include an explanation of how the requirements of 35 U.S.C. 135(b) are met. If this explanation is not provided, a one-month time period should be set for correction of this deficiency.

The explanation under 37 CFR 1.607(a)(6) must be considered by the examiner to determine whether the "substantially the same subject matter" requirement of 35 U.S.C. 135(b) has been met. In order for an application claim to be for "substantially the same subject matter" as a patent claim, it must contain all the material limitations of the patent claim. *Parks v. Fine*, 773 F.2d 1577, 227 USPQ 432 (Fed. Cir. 1985), modified, 783